

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 21, 00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Clark Retail Enterprises, Inc.

Serial Nos. 75/326,773 and 75/327,725

Robert A. Schuckman of Jenner & Block for Clark Retail
Enterprises, Inc.¹

John E. Michos, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Simms, Bucher and Holtzman, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Clark Refining and Marketing, Inc., a Delaware
corporation, has filed two applications for registration of
the mark "GREAT GAS. GREAT PRICE.," one for "convenience
store services and wholesale distributorship featuring
gasoline"² and a second for "self service gas stations."³

¹ In December 1999, Clark Retail Enterprises, Inc., successor
in interest to the original applicant, appointed new counsel.
However, Robert T. Johnson, Jr., Melissa Masiello, and Sana Hakim,
all attorneys from the firm of Bell Boyd and Lloyd, represented
applicant from the time the applications were filed (July 1997)
through the reply briefs on appeal (July 1999 and September 1999,
respectively).

² Serial No. 75/326,773, filed on July 18, 1997, based upon an
allegation of a *bona fide* intention to use the mark in commerce.
The records of the U.S. Patent and Trademark Office reflect the

Inasmuch as both of these applications involve common questions of law and fact, and each has been treated in substantially the same manner by the applicant and by the Trademark Examining Attorney, we have consolidated these two appeals by issuing a single decision.

The Trademark Examining Attorney issued final refusals to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that if applicant's proposed mark were used in connection with these convenience store services, the distributorship of gasoline, and with self service gas stations, it would be merely descriptive of applicant's services.

Applicant has appealed the refusals to register based upon the alleged merely descriptive nature of the mark. Briefs have been filed, but applicant did not request an

fact that applicant assigned the entire interest and the goodwill to OTG, Inc. on July 8, 1999 (Reel 1925, Frame 818 and Reel 1953, Frame 510). Inasmuch as no amendment alleging use has been filed, we assume under Section 10 of the Trademark Act, 15 U.S.C. §1060, that OTG, Inc. is a successor to that portion of the business to which the mark pertains and that the business is ongoing and existing. Then a further change of name executed on July 12, 1999, from OTG, Inc., to "Clark Retail Enterprises, Inc.," was recorded at Reel 1953, Frame 489.

³ Serial No. 75/327,725, also filed on July 18, 1997, based upon an allegation of a *bona fide* intention to use the mark in commerce. The same Patent and Trademark Office assignment records reflected in footnote 2, *supra*, as to Ser. No. 75/326,773, have resulted in identical changes to this property.

oral hearing. We affirm the refusal to register in both case files.

A mark is unregistrable under Section 2(e)(1) of the Trademark Act as merely descriptive of the services with which it is used if it immediately and forthwith conveys information about the characteristics, features or functions of those services. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Accordingly, the Trademark Examining Attorney contends that the wording "GREAT GAS. GREAT PRICE.," immediately tells potential purchasers that applicant will "...offer high quality gasoline at what the applicant contends is a great price." (Trademark Examining Attorney's appeal brief, p. 6). His analysis is fairly straightforward. He argues that the mark sought to be registered ("GREAT GAS. GREAT PRICE.") consists of a laudatory phrase. If, for example, one takes the ordinary meaning of words like "great," "gas" and "price" in the context of this composite, the resulting slogan attributes high quality or superiority to applicant's gasoline which, in turn, is being sold at a relatively low price. He concludes then that this is nothing more than an informational slogan of the type frequently used in marketing such commodities.

By contrast, applicant argues that the word "great," in both of its appearances herein, is a vague and a subjective term not given to quantification.⁴ However, applicant does not appear to dispute the laudatory connotation of individual components of the composite. Rather, while applicant concedes that the word "great" may be laudatory, it argues that this entire coined phrase has the requisite degree of creativity and vagueness to escape the clutches of Section 2(e)(1) of the Lanham Act. Furthermore, applicant argues that, in light of its precedents, the Board should find this slogan to be suggestive, not merely descriptive.⁵

⁴ We disagree with applicant's conclusions that "great gas" is itself not merely descriptive because the potential consumer will not know if this is referring to the gasoline being high octane, causing enhanced engine performance, or resulting in better gas mileage, etc. The exact equivalent herein of the term "great gasoline" is deemed to be laudatory, and hence merely descriptive, without having to be that specific in its advertising claims. Our reasoning is similar as to the term "great price," although this term is even more straightforward.

⁵ We also note that some of the cases cited by applicant, and portions of its brief, deal with issues of "capability." While the highly descriptive nature of this slogan is such that its capability may be suspect, that is not the issue in these cases. These are applications to register a mark on the Principal Register. Hence, the issue herein is the mark's inherent distinctiveness, not whether this matter is capable of acquiring distinctiveness. *Contra In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058 (Fed. Cir. 1989) ["The test [on the Supplemental Register] is not whether the mark is already distinctive of the applicant's goods, but whether it is capable of [distinguishing the applicant's goods or services, 15 U.S.C. §1091]..."]. See also "[Applicant] cited to cases which hold that laudatory terms are capable of functioning as trademarks..." (Applicant's brief, p. 4).

There is no dispute that a laudatory term which attributes superior quality and/or greater value to a product or service is merely descriptive. Professor McCarthy refers to such matter as "self-laudatory terms." As explained in 2 J. McCarthy, McCarthy on Trademarks & Unfair Competition §11.17 (4th ed. 1999):

Marks that are merely "laudatory" and descriptive of the alleged merit of a product are also regarded as being "descriptive." This includes such terms as ... PREFERRED, DELUXE, GOLD MEDAL, BLUE RIBBON, SUPER BUY, and the like.

Since each tangible product carries with it a "psychic load" of intangible consumer psychological expectations about the product, a mark could be "descriptive" of the product itself or those intangible expectations, or both. Self-laudatory or "puffing" marks are regarded as a condensed form of describing the character or quality of the goods...

The Trademark Examining Attorney's refusal is supported if one simply takes the ordinary meanings of each of these words from the dictionary entries and evaluates them in the context of the overall composite. When viewing these four words as a two-part sales slogan, it takes no imagination to know exactly what this describes - namely, that these services involve quality gasoline at a competitive price. We concur with the conclusion of the Trademark Examining Attorney that the connotation of the phrase "GREAT GAS. GREAT PRICE.," is readily apparent. Other gasoline

distributors around the nation likely assume, with good reason, that they could freely use such descriptive terms to tout their own products and/or services at convenience stores selling self-serve gasoline.

Certainly, there are examples of where common, ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to words when used separately. However, we apprehend no double meanings within this simple slogan and do not perceive the requisite degree of cleverness that might take this out of the category of being merely descriptive. In adopting this specific formulation, applicant has not created any new double or incongruous meaning for the combined phrase. In short, the term "Great gas. Great price.," does not require imagination, thought or perception to reach a conclusion as to the nature of the services, and therefore it cannot be considered a suggestive term. Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990) [Term "THE PROFESSIONAL PORTFOLIO SYSTEM" is merely descriptive of computer-based portfolio valuation systems].

We see nothing herein with the joining of the words "great gas" to the term "great price" that creates a new or different meaning than one would anticipate when melding these individual components. The first term would convey

information immediately to the potential purchaser as to the alleged quality of the gasoline, while the second term would point out the alleged price advantage.

Applicant has compiled a listing of federal trademark applications and registrations⁶ "...which contain the word 'great' and which do not disclaim 'great' or invoke Section 2(f)." (Applicant's brief, p. 2). Then applicant argues that its mark "... is no more descriptive than each of the registrations [containing the word "great" that applicant] set forth..." (Applicant's brief, p. 4).

We do not feel constrained to justify the decisions of each of a dozen different Trademark Examining Attorneys over a period of many years who approved these specific marks for registration. Furthermore, the absence of a §2(f) indication is inconclusive, as the Office has not always printed this information on registration certificates.⁷

Additionally, not all slogans or laudatory terms are created equally. As the predecessor to our principal reviewing court noted:

The determination of whether a given slogan is a registrable trademark is a matter which historically has not been free of difficulty (footnote omitted). Nor is it an easy task

⁶ We do note that some of the listed applications never issued, and several of the registrations have now expired or been cancelled.

⁷ See In re Men's International Professional Tennis Council, 1 USPQ2d 1917, 1919 (footnote 9) (TTAB 1986).

here. The mere fact that a combination of words or a slogan is adopted and used by a manufacturer with the intent Clairol has manifested here -- that it identify its goods and distinguish them from those of others -- does not necessarily mean that the slogan accomplishes that purpose in reality. See In re The Standard Oil Co., 275 F.2d 945, 125 USPQ 227 (CCPA 1960).

Roux Laboratories, Inc. v. Clairol Incorporated, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970) [Ad slogan "HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE" was originally descriptive, but Court acknowledged evidence of acquired distinctiveness].

In this context, it is instructive to review the valid and subsisting registrations listed by applicant. To the extent that the registered slogans, in their entireties, are longer or more complex,⁸ to the extent they employ double entendres or involve a play on literary expressions,⁹ to the extent that they are built around alliteration or rhyming techniques,¹⁰ to the extent that they incorporate house marks or other arbitrary matter,¹¹ they are not analogous to the

⁸ See e.g., "THE GREAT TASTE OF CRAB AT A PRICE THAT WON'T PINCH," Reg. No. 1,568,640.

⁹ See e.g., "GREAT GATTI'S," Reg. No. 2,126,057, and mark in footnote 7, *supra*.

¹⁰ See e.g., "GREAT PRICE, GREAT ADVICE." Reg. No. 1,651,132.

¹¹ See e.g., "STARZ! AND ENCORE TWO GREAT CHANNELS, ONE LOW PRICE," Reg. No. 1,994,544; and "THE GREAT CHEFS OF HAMPTON ROADS," Reg. No. 1,716,672.

instant case merely because they include the word "great" somewhere within the composite.¹²

After careful consideration of the arguments of the attorneys, we conclude that these words comprise a laudatory phrase and, as a result, we find that the Trademark Examining Attorney herein has more than adequately demonstrated that the asserted mark would be merely descriptive of applicant's services.

Decision: Both refusals of registration under Section 2(e)(1) are hereby affirmed.

R. L. Simms

D. E. Bucher

T. E. Holtzman

Administrative Trademark
Judges, Trademark Trial and
Appeal Board

¹² Furthermore, to the extent a mark (or a portion of a mark) is considered "unitary," the disclaimer of a non-distinctive component is not appropriate. See TMEP §1213.06(a).